Docket No.: A8130.0157/P157
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jeffrey Wyman et al.

Application No.: 10/679,438

Confirmation No.: 3674

Filed: October 7, 2003

Art Unit: 3731

For: SUTURE RETRIEVER WITH IN-LINE ACTUATING HANDLE

Examiner: K. C. Sonnett

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Reply Brief pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed February 28, 2011 in connection with the appeal from the final rejection of claims 1-5, 11 and 12 dated July 27, 2010 in the above-identified U.S. patent application.

I. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 7 claims pending in application. The application contains claims 1-5, 11 and 12, which were finally rejected and are currently under appeal.

B. Current Status of Claims

1. Claims canceled: 6-10, 13-16
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1-5, 11 and 12
4. Claims allowed: none
5. Claims rejected: 1-5, 11 and 12

C. Claims On Appeal

The claims on appeal are claims 1-5, 11 and 12.

II. GROUNDS OF REJECTIONS TO BE REVIEWED ON APPEAL

Whether the rejection of claims 1-5 under 35 U.S.C. §103(a) as being unpatentable over Nord (U.S. Patent No. 6,074,403) ("Nord") in view of Miller (U.S. Patent No. 2,518,994) and Schmidt et al. (U.S. Patent No. 5,456,684) ("Schmidt") should be reversed.

Whether the rejection of claims 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Nord in view of Dingler (U.S. Patent No. 6,071,299) ("Dingler") should be reversed.

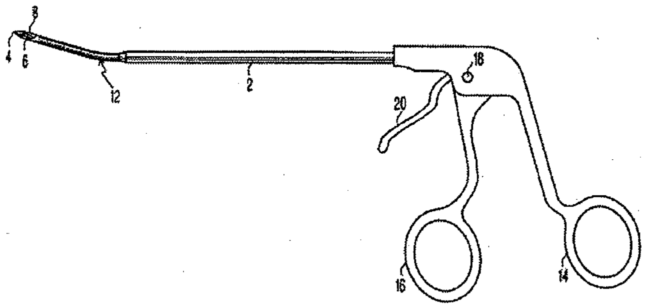
III. ARGUMENT

Although the Examiner's Answer does not raise any new grounds for rejection, Appellants briefly respond to the Examiner's remarks regarding Appellants' arguments in the Appeal Brief. Appellants incorporate all comments from Appellants' Appeal Brief dated January 14, 2011. Appellants provide the following comments in response to the Examiner's arguments on pages 6-8 of the Examiner's Answer.

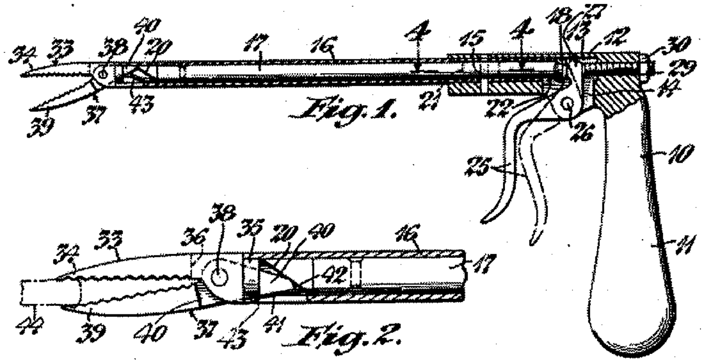
In the "Response to Argument" section, the Examiner disagrees with the Appellants' conclusion that the combined references fail to disclose a lever that toggles between two positions that are symmetric (Examiner's Answer at 7). Appellants disagree with the Examiner's conclusion for at least the following four reasons:

First, Nord, Miller and Schmidt (alone or in combination) do not disclose or suggest "a single lever disposed pivotably on the handle and manipulable by a user's thumb, while the handle is held across the palm of the user's hand and the handle is gripped in the user's hand and . . . to toggle in an arc between two opposed positions, the two opposed positions being symmetric with respect to each other relative to a direction transverse to a longitudinal axis of the shaft," as claim 1 recites.

As shown in Fig. 1 of Nord (reproduced below), lever 20 of Nord does not "toggle in an arc between two opposed positions . . . being symmetric with respect to each other relative to a direction transverse to a longitudinal axis of the shaft," as in the claimed invention. Lever 20 of Nord is also not "manipulable by a user's thumb, while the handle is held across the palm of the user's hand and the handle is gripped in the user's hand." More importantly, lever 20 of Nord is designed for locking the jaws (col. 2, ll. 62-63), and not for actuating the jaws, as in the claimed invention.



Like lever 20 of Nord, lever 25 of Miller (shown in Figs. 1 and 2, reproduced below) cannot -- and does not -- "toggle in an arc between two opposed positions, the two opposed positions being symmetric with respect to each other relative to a direction transverse to a longitudinal axis of the shaft," as claim 1 recites. Clearly, the handle of the forceps of Miller cannot be "held across the palm of the user's hand" and also "gripped in the user's hand," to allow a lever on the handle to be "manipulable by a user's thumb." In fact, Miller specifically teaches that "the finger lever 25 is depressed by the index finger" (col. 3, ll. 30-31), and not by a thumb.



Schmidt teaches a multifunctional instrument with jaws 18, 20, a suction button 34, an irrigation button 36, and a retractable cutting blade 22. There is no indication or description in Schmidt, however, that trigger 31 of Schmidt (which would arguably correspond to the "single lever" of the claimed invention) can actually "toggle in an arc between two opposed positions, the two opposed positions being symmetric with respect to each other relative to a direction transverse to a longitudinal axis of the shaft," as claim 1 recites.

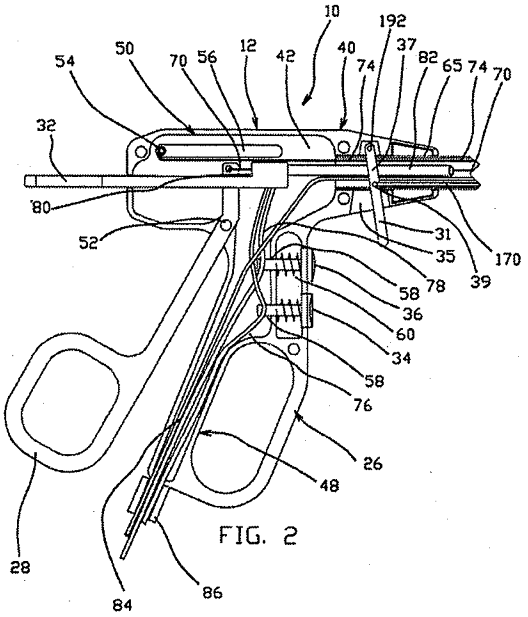


FIG. 2

Like the instruments of Nord and Miller, the instrument of Schmidt (provided with finger loops 26, 28) is also not designed to be actuated by a thumb and is not part of a handle that is held across the palm of the user's hand and gripped in the user's hand. The instrument of Schmidt includes finger loops which is exactly what the claimed invention teaches against and tries to overcome.

More importantly, trigger 31 of Schmidt does not actuate any jaws (i.e., does not engage a rod that moves to operate an articulating mechanism "in communication with [a] sharp distal end) but rather allows rods 70 and 74 (and section tube 82) to bend at joint 160 (col. 5, ll. 57-60; Fig. 1, reproduced below).

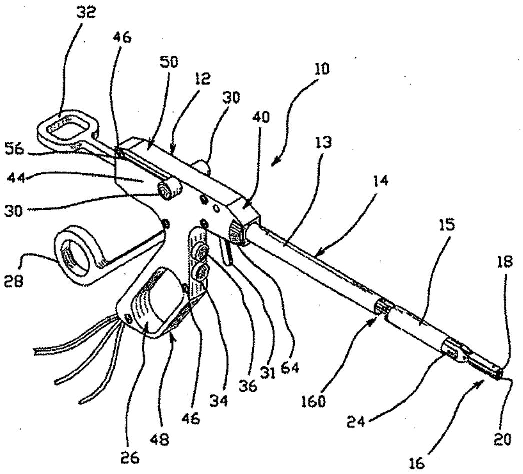


FIG. 1

Second, none of Nord, Miller or Schmidt discloses or suggests an instrument with a lever that toggles between symmetric opposed positions (relative to the longitudinal axis of the instrument) and that "operate[s] the articulating mechanism" that is "in communication with the sharp distal tip" which is "for capturing and retrieving suture within a patient's body." Nord teaches lever 20 which does not toggle between symmetric opposed positions and is designed for locking the jaws (col. 2, ll. 62-63), and not for actuating the jaws. Miller teaches a forceps with shear blades and with lever 25 which does not toggle between symmetric opposed positions and which is not designed to actuate a sharp distal tip that is "for capturing and retrieving suture within a patient's body." Schmidt teaches trigger 31 which does not actuate any jaws but rather bends rods 70 and 74 (and section tube 82) at joint 160 (col. 5, ll. 57-60).

Third, a person skilled in the art would not have been motivated to consider any of Nord, Miller or Schmidt, as all these references are directed to handles with finger loops (Nord and Schmidt) and handle member and hand grip (Miller) which do not permit the handles of these references to be held across the palm of the user's hand and gripped in the user's hand (while the surgeon actuates a lever by simply using the thumb). The claimed invention teaches exactly against these references (see Nord which was cited by Applicants in the "Background of the Invention" section of the application) and, thus, one skilled in the art would simply not be motivated to consider them (much less to combine them) to arrive at the claimed invention.

Fourth, a person skilled in the art would also not have been motivated to combine Schmidt with Miller and/or Nord, to arrive at the claimed invention. Schmidt teaches an instrument that can perform a multitude of tasks such as grasping, manipulating, retracting, cutting, cauterizing, irrigation, suction, and electrosurgery functions (abstract). The instrument of Schmidt is provided with a tool assembly (having jaws, cutting blades and a suction/irrigation tip) and with a handle that has finger loops 26, 28, a trigger 31 and switches and buttons 32, 34, 36. There is simply no motivation for one skilled in the art to select a particular, specific element of Schmidt (i.e., trigger 31) out of a multitude of similar structural elements (such as finger loops 26, 28 and switches and buttons 32, 34, 36) to modify the lever of Miller and further the lever of Nord, to address a problem that does not even exist in either Miller or Nord. Even if *arguendo* the references would be combinable, a modified lever in Nord (that would *arguendo* toggle as in the claimed invention) would still not actuate jaws "for capturing and retrieving suture within a patient's body" but rather for locking the jaws; the instrument of Nord would still retain finger loops 14, 16 for actuating the jaws (which is exactly what the claimed invention teaches against).

Appellants maintain all remarks and arguments set forth in the January 14, 2011 Appeal Brief regarding (i) the lack of motivation for one skilled in the art to consider Nord (much less to combine Nord with other prior art references) to arrive at the claimed invention, when Nord specifically teaches against the claimed invention and was cited by Applicants in the "Background of the Invention" section of the present application (as an example of what the present application is teaching against and tries to overcome); (ii) the failure of Nord and Dingler (alone or in combination) to disclose or suggest all limitations of claims 11 and 12 (i.e., a specific structure with a "pliers-like grip" and with a stationary handle and a movable lever that are "adapted to be gripped by a user's palm without the need for finger or thumb rings"); and (iii) the lack of motivation for one skilled in the art to combine Nord with Dingler, to arrive at the claimed invention.

Dated: March 23, 2011

Respectfully submitted,

By Steph A Soff
Stephen A. Soffen
Registration No.: 31,063
Gabriela I. Coman
Registration No.: 50,515
DICKSTEIN SHAPIRO LLP
1825 Eye Street, NW
Washington, DC 20006-5403
(202) 420-2200
Attorneys for Appellants